

REMARKS

Claims 16-18 have been added. Support for these claims can be found in the paragraph bridging pages 13-14 of the specification, and in all of the specific compounds and the compounds used in the Examples in the present application, R₁ is an unsubstituted alkyl group, except for a compound having at least two structures of the formula (I) through a linkage group.

Claims 1-18 are pending in the application.

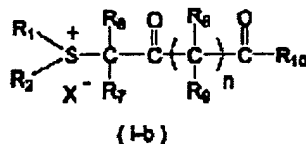
Claims 1, 2, 4, 5, 10, and 12-15 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Aoso et al. ("Aoso"), JP 2002-255930 and DERWENT English Abstract for the Japanese document.

Claim 7 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Aoso et al. ("Aoso") (JP 2002-255930 and DERWENT English Abstract for the Japanese document) in view of Watanabe et al., U.S. Patent No. 6,613,844 B2 ("Watanabe '844").

Claim 8 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Aoso et al. ("Aoso") (JP 2002-255930 and DERWENT English Abstract for the Japanese document) in view of Nitta et al., U.S. Patent No. 6,605,417 B2 ("Nitta").

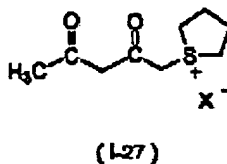
Claim 11 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Aoso et al. ("Aoso") (JP 2002-255930 and DERWENT English Abstract for the Japanese document) in view of Watanabe et al., U.S. Patent No. 6,818,148 B2 ("Watanabe '148").

Aoso, the primary reference cited in the rejections, discloses an acid-generating compound with the generic formula (I-b).



Aoso teaches that that R_6 and R_7 in the generic formula (I-b) can be an H atom, *alkyl*, haloalkyl, cycloalkyl, alkenyl, aryl, aralkyl, acyl, alkoxycarbonyl or $-S-R_5$.

Aoso teaches an acid-generating compound (I-27), which is a specific example of a compound of the generic formula (I-b).



In Aoso's compound (I-27), both R_6 and R_7 are hydrogen atoms. However, in Applicants' formula (I), R_2 and Y are alkyl groups. Aoso does not disclose an example of a specific compound wherein R_6 and R_7 are alkyl groups. A genus does not always anticipate a species within that genus. See *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.* 868 F.2d 1251, 1262 (Fed. Cir. 1989). When a compound is not specifically named, but instead it is necessary to select portions of teachings within a reference to combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula.

MPEP 2131.02; *In re Petering*, 301 F.2d 676, 682 (C.C.P.A. 1962). Applicants submit that one of ordinary skill in the art would not immediately envisage replacing the hydrogen atoms in the R₆ and R₇ positions with two alkyl groups. Accordingly, Applicants submit that the present invention would not be anticipated by Aoso.

Additionally, Applicants submit that the present invention in which R₂ and Y are alkyl groups provides unexpectedly superior results as compared with Aoso's compound (I-27) in which R₆ and R₇ are hydrogen atoms. Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 demonstrating the unexpectedly superior results of Applicants' formula (I) as compared with Aoso's compound (I-27). Applicants submit that the unexpectedly superior effect of the present invention can also be demonstrated by a comparison between Example 1 and Comparative Example 1 of the present application. With respect to Example 1 and Comparative Example 1, it is apparent that the compound of the present invention (R₂ and Y are alkyl groups) shows a unexpectedly high sensitivity and excellent pattern profile as compared to the comparative compound (R₆ and R₇ are hydrogen atoms). Likewise, the compound of the present invention has an unexpectedly high sensitivity and excellent effect as compared with Aoso's compound (I-27), as depicted in the § 132 Declaration.

In view of the above, Applicants submit that the claimed invention would not be anticipated or obvious over Aoso alone or over Aoso in view of Watanabe '844, Aoso in view of Nitta, or Aoso in view of Watanabe '148. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejections.

Appln. No.: 10/668,348
Amendment under 37 C.F.R. § 1.111

Q77664

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

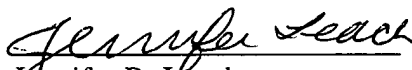
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER


Jennifer R. Leach
Registration No. 54,257

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